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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,661	07/20/2001	Vishnu K. Agarwal	500431.04	3239

27076 7590 10/17/2002

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EXAMINER

GOUDREAU, GEORGE A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09-910661	Applicant(s) Agarwal
Examiner George Goudreau	Group Art. Unit 1763

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on (6-02-01 to 10-02-01) (i.e., -paper # 10-13)
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 68-72, 78-93 is/are pending in the application.
- Of the above claim(s) 790-93 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 68-72, 78-89 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10, 12, 13
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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15. Newly submitted claims 73-88 have been renumber by the examiner as claims 78-93 since applicant cannot reuse claim numbers which were previously canceled by the applicant in a previous amendment. (i.e.-Claims 73-77 were previously canceled by the applicant.)

16. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 68, and 78-89, drawn to a cmp polishing apparatus, classified in class 156, subclass 345.
- II. Claims 90-93, drawn to a semiconductor substrate, classified in class 257, subclass 1 (+).

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as one in which a different type of substrate than that which is claimed by the applicant is cmp polished.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Newly submitted claims 90-93 are directed to an invention that is independent or distinct from the invention originally claimed for the same reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 90-93 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 68-72, and 78-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied in any of paragraphs 17 or 19 of the previous office action.

The reference as applied in any of paragraphs 17 or 19 of the previous office action fail to disclose the following aspects of applicant's claimed invention:

-the specific cmp polishing of the type of substrates which are claimed by the applicant in applicant's apparatus claims

In regards to applicant's recitation in their apparatus claims that they cmp polish specific types of wafers, the examiner cites the case law listed below of interest to the applicant.

Furthermore, it is obvious to one skilled in the art that the configuration of the substrate worked upon by the apparatus claimed in this invention is not patentable in view of In re Young

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(25 U.S.P.Q. 69, 71 (CCPA 1935)) and In re Rishoi (94 U.S.P.Q. 71,73 (CCPA 1952)). The Court of Customs and Patent Appeals stated in In re Young that inclusion of material worked upon by a machine as element in claim may not lend patentability since claim is not otherwise allowable. Similarly, the Court of Customs and Patent Appeals stated in In re Rishoi that there is no patentable combination between a device and the material upon which it works.

Thus, it is irrelevant that the cmp polishing apparatuses in the prior art used to reject applicant's apparatus claims do not specifically teach the cmp polishing of the types of wafers which are claimed by the applicant since these cmp apparatus are inherently capable of processing these types of wafers. Further, the wafer which is cmp polished is not part of the apparatus which is claimed by the applicant since the cmp apparatus claimed by the applicant may be used to cmp polish other types of substrates than those which are specifically claimed by the applicant.

19. Applicant's arguments filed 7-23-02' have been fully considered but they are not persuasive.

The applicant argues the following points regarding the examiner's rejection of their claimed subject matter.

-Applicant argues that their newly presented apparatus claims now distinguish over the prior art of record based upon the types of wafers which are processed through their cmp apparatus.

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The examiner must disagree.

-The wafers which are processed through applicant's claimed apparatus are not part of the apparatus since the cmp apparatus which is claimed by the applicant may be used to process other types of substrates than those which are claimed by the applicant. Further, the cmp apparatuses taught by the prior art used to reject applicant's apparatus claims are inherently capable of processing the types of wafers which are claimed by the applicant.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner George A. Goudreau whose telephone number is (703) -308-1915. The examiner can normally be reached on Monday through Friday from 9:30 to 6:00.

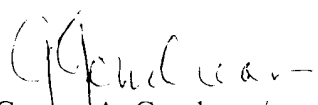
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Examiner Gregory Mills, can be reached on (703) -308-1633. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) -306-3186.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-0661.


George A. Goudreau/gag

Primary Examiner

AU 1763